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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,663	04/13/2004	Katsuaki Takahashi	KAS-204	3101

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MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.  
1800 DIAGONAL ROAD  
SUITE 370  
ALEXANDRIA, VA 22314

EXAMINER
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WRIGHT, PATRICIA KATHRYN

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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01/17/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/822,663

**Applicant(s)**

TAKAHASHI ET AL.

**Examiner**

P. Kathryn Wright

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/2004, 10/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of the Claims***

1. This action is in response to papers filed October 19, 2007 in which claims 1-11 were canceled and claims 12-19 were added. The amendments have been thoroughly reviewed and entered.

The previous rejections in the Office Action dated June 19, 2007 are withdrawn in view of the amendments. Applicant's arguments have been thoroughly reviewed but are deemed moot in view of the amendments, withdrawn rejections and new grounds for rejection. New grounds for rejection, necessitated by the amendments, are discussed. Any objection/ rejection not repeated herein has been withdrawn by the Examiner.

Claims 12-19 are under prosecution.

### ***Information Disclosure Statement***

2. In view of Applicant's remarks, filed October 19, 2007, the information disclosure statement filed April 13, 2004, does comply with 37 CFR 1.98(a)(3) because the specification does provide a concise explanation of the relevance of each patent listed that is not in the English language (i.e. JP 6-64070). Thus, the information referred to therein has been considered by the Examiner.

***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "mechanism for causing" in new claim 14.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent no. 5,670,114 to Sakazume et al., hereinafter "Sakazume".

Sakazume teaches an automatic analyzer that includes a dispensing mechanism 2 for dispensing a fluid from a sample container, a container disk 6 arranged to accommodate a plurality of containers arranged circularly on the container disk which transfers the containers to a dispensing position of the dispensing mechanism by rotating, an information reader 7 arranged to read information recorded on an information recording medium 13 (barcode) attached to the container positioned at the information reading position, and a hand-contact preventing plate (covers 10, 15)

arranged at the dispensing position and at the information reading position (see col. 3, line 26 et seq. and Fig. 2)

With respect to claim 13, the hand-contact preventing plates of Sakazume comprise a portion covering at least one part of a moving locus of a top end of a probe of the dispensing mechanism (see Fig. 2).

Regarding claim 14, Sakazume teaches mechanisms (54 and 78, 77) for causing the hand-contact preventing plates 10, 15 to retreat from a position covering the container disk.

With respect to claim 15 the Sakazume apparatus further comprises a detector 12 for detecting the retreat of the hand-contact preventing plate 10 from the position covering the container disk, and a controller (16, microcomputer) for stopping the dispensing operation of the dispensing mechanism when the detector detects the retreat of the hand-contact preventing plate from the position covering the container disk (col. 3, lines 26-29).

Please note that a recitation with respect to the manner in which a claimed apparatus is intended to be employed, (i.e., sample analyzer) fails to differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakazume (US Patent no. 5,670,114) in view of Ishizawa (US Patent no. 6,413,475)

The teachings of Sakazume have been summarized previously, *supra*.

Sakazume does teach hand-contact preventing plate (11, 15); however, Sakazume does not explicitly teach the plates made from an electrically conductive material which is electrically grounded.

Ishizawa teaches an analyzer system having a guard 13 used to prevent a foreign article from approaching the probe during an operation of the sample pipetting probe 105, and especially, to prevent a hand of the operator from contacting the pipetting probe. The guard 13 may be constituted of metal (i.e., electrically conductive material). The guard department 13 also includes plates 14a,b made from a conductive material 14 is contacted with ground when the sample disc is electrically contacted with ground. The conductive material 13 and 14 acts as liquid level detecting means designed to reduce the dipping depth of the pipetting probe as much as possible, which in turn, reduces the quantity of the sample liquid adhered to an outer wall of the probe and the likelihood of the cross-contamination between liquid containers (see background of invention section of Ishizawa).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have included in the analyzer system of Sakazume, the electrically conductive hand-contacting plate of Ishizawa, in order to reduce the quantity of the sample liquid adhered to an outer wall of the probe which, in turn, reduces the likelihood of the contamination (see background of invention section of Ishizawa).

### ***Conclusion***

9. No claims allowed.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Wright whose telephone number is 571-272-2374. The examiner can normally be reached on Monday thru Thursday, 9 AM to 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.




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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

pkw

  
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